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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,548	04/14/2004	Daniel B. Roitman	10030531-1	6420

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
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EXAMINER

YU, MELANIE J

ART UNIT PAPER NUMBER

1641

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/824,548

Applicant(s)

ROITMAN ET AL.

Examiner

Melanie Yu

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).


10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.


CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641

Continuation of 11. does NOT place the application in condition for allowance because: for the reasons stated in the previous office action dated 2 December 2005.

Applicant argues that Jacobson et al. fails to disclose electrochemistry and discloses manipulating charged nanoparticles electrostatically. Applicant argues that electrostatics and electrophoresis are distinct from the presently claimed electrochemical process. However, in response to applicant's arguments, although Jacobson et al. does not specify the deposition process as electrochemical, the deposition process of Jacobson et al. teach the same method as disclosed in the instant specification at page 8, paragraph 23, wherein the electrochemical deposition of the detector nanoparticles is provided by an electric potential applied to a conductive substrate and catalyzing the deposition of nanoparticles. Similarly, as described in the previous office action, Jacobson et al. teach applying a voltage to a conductive substrate wherein an application of voltage creates deposition of nanoparticles on a conductive substrate. Furthermore, the instant specification, describes the electrochemical deposition catalyzed by using galvanostatic forces, which are similar to the electrostatic forces used in Jacobson et al. Although Jacobson et al. fail to specify electrochemical deposition of nanoparticles, the deposition process is the same process that is defined as electrochemical by the instant specification. Therefore the deposition process of Jacobson et al. is electrochemical as defined by the instant specification.

Applicant also argues that the "Raman active reporter molecule" of Porter et al. is not a second nanoparticle because the majority of Raman-active reporter molecules listed by Porter et al. are dyes and the very end of paragraph 46 indicates that the reporter molecule can be a polymeric particle and would therefore be a second nanoparticle. Applicant further argues that Porter does not suggest that this particle might be suitable for an electrochemical reaction with a nanoparticle. However, claim 1 merely recites that the complex must be electrochemically formed on a conductive substrate and does not specifically recite that the complex must be formed electrochemically. Furthermore, Porter et al. is not relied upon for forming a complex electrochemically and Jacobson et al. is relied upon for this limitation.